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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,454	01/15/2004	Baychar	BAY-800	5065

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,454

Applicant(s)

BAYCHAR,

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10132005, 01062006</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips, Jr. et al. 4,845,862 in view of Tomaro 5,499,459. Phillips, Jr. et al. '862 discloses all the limitations substantially as claimed including the following: a soft boot 10 comprising a moisture transferring lining material 22; a frothed (foamed) breathable open-cell foam material 24; a moisture transferring non-woven material 26; a soft exterior shell material 50. The moisture from the user's foot transfers from the foot through all the material to the outside of the shell, thereby allowing the foot to breathe. Phillips, Jr. et al. '862 does not disclose the soft exterior shell material being waterproof or waterproof by encapsulation. Tomaro '459 teaches that the outer layer of a bootie (soft boot) for a shoe can be made waterproof and breathable by having an outer layer 22 formed of a waterproof membrane 24 placed over and surrounding the outer layer of the bootie to provide protection to the wearer's foot against water infiltration. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the outer layer of the boot of Phillips, Jr. et al. '862 waterproof and breathable, as taught by Tomaro '459, to allow the user's perspiration to exit the shoe and prevent water from entering the shoe, making the shoe more comfortable to wear.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips, Jr. et al. 4,845,862 in view of Tomaro 5,499,459, as applied to claim 1 above, in view of Phillips, Jr. et al. 3,020,169. Phillips, Jr. et al. '862 in view of Tomaro 5,499,459, as applied to claim 1 above, disclose all the

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limitations of the claim except for at least one layer of the soft boot including fibers flocked to at least one side of the at least one layer. Phillips, Jr. et al. '169 teaches that a lining for a shoe upper can contain fibers flocked to one side thereof to prevent slipping of the user's foot within the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to flock fibers to any one of the layers of the upper to prevent slipping of the user's foot or the layers with respect to one another during use of the boot.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, in view of Morishita et al. 4,015,347. The references as applied to claim 2 above disclose all the limitations of the claim except for the flocked fibers being silver fibers. Morishita et al. '347 teaches that shoe parts can contain silver fiber to aid in preventing or treating athlete's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to flock silver fibers to the inside layer of the upper to aid in preventing or treating athlete's foot during use of the boot.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over the reference as applied to claim 1 in view of Official Notice. The references as applied to claim 1 disclose all the limitations of the claim except the use of encapsulation for waterproofing the outer layer. Official Notice is taken that encapsulation, at the time the invention was made, was a well known process for making the outer layer of an inner boot waterproof (for example of this, see Baychar 5,738,937 where it states "encapsulation technology is being utilized by a company called Mectex, Inc." This admits that the technology of encapsulating the outer layer was known and used prior to the filing of the application on November 12, 1996.)/ Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to waterproof the outer layer of the references as applied to claim 1 above by encapsulation as this method of waterproofing the outer layer was already well known in the art.

*Response to Arguments*

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Although applicant's arguments may be moot, it is deemed necessary to clear up the understanding of the term "frothed". As defined, the term "frothed" means foamed. Since the foam used in the references are foamed, they would meet the limitation of the term "frothed" as used in the claim. If applicant intends to use the term "frothed" as a verb, then this part of the claim would be a method step that would not be necessary for the examiner to find since the applicant is not claiming the method but the structure of the boot. With respect to the argument that the knit of Phillips, Jr. et al. '862 does not meet the limitation of a non-woven material, it is submitted that knitting is connecting loops or tying together, neither of which meets the definition of a "woven" material.

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS